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FLETCHER YODER (ILLINOIS TOOL WORKS INC.)
P.O. BOX 692289
HOUSTON, TX 77269-2289

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HOOK, JAMES F

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PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK DAVID RESENDES

Appeal 2015-001286^{1,2}
Application 12/689,931
Technology Center 3700

Before JOSEPH A. FISCHETTI, PHILIP J. HOFFMANN, and
AMEE A. SHAH, *Administrative Patent Judges*.

HOFFMANN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

According to Appellant, “[t]he invention relates generally to an air hose assembly, and[,] more particularly, to a hose assembly that facilitates

¹ Our decision references Appellant's Specification (“Spec.,” filed Jan. 19, 2010) and Appeal Brief (“Appeal Br.,” filed May 19, 2014), as well as the Final Office Action (“Final Action,” mailed Nov. 19, 2013) and the Examiner's Answer (“Answer,” mailed Sept. 3, 2014).

² Appellant indicates that Hobart Brothers Company is the real party in interest. Appeal Br. 2.

the transfer of preconditioned air from an air delivery system to a destination, such as an aircraft.” Spec. ¶ 2. Claims 1, 10, and 15 are the only independent claims on appeal. *See* Appeal Br., Claims App. We reproduce claim 1, below, as representative of the appealed claims.

1. An air hose delivery assembly, comprising:
an external conduit; and
a continuous inner liner disposed within the external conduit and secured to the external conduit only at ends of the continuous inner liner to form a tubular structure configured to be collapsed to a flat structure.

Id.

REJECTION AND PRIOR ART

The Examiner rejects claims 1–20 under 35 U.S.C. § 103(a) as unpatentable over Kolzumi (US 2008/0185064 A1, pub. Aug. 7, 2008) and Berardi (US 8,291,941 B1, iss. Oct. 23, 2012). *See* Final Action 2–3; *see also* Answer 2–3.

ANALYSIS

Independent claim 1 recites, among other limitations, “a continuous inner liner disposed within the external conduit and secured to the external conduit only at ends of the continuous inner liner.” Appeal Br., Claims App. The Examiner finds that

Kolzumi discloses all of the recited structure with the exception of the liner only being connected to the outer layer at the ends. The reference to Berardi discloses that it is old and well known in the art to form the inner single continuous layer 14 and outer layer 12 of hoses that are only connected at the ends of the hose to assist with storage of the hose.

Final Action 3; *see also* Answer 3. In response to Appellant's argument that "Berardi does not qualify as prior art" (Appeal Br. 7) (emphasis omitted), with which we agree, the Examiner determines that

[Berardi is] used only as evidence and not as part of a combination, and since such is only being used for evidence is not required to pre-date the filing date of the instant application. The Berardi reference sets forth that it is known in the art to not connect the inner and outer layers of hoses, where the only connection would be formed by the connectors at the ends, and that such is old and known in the art. Berardi references at least a couple references in the background section of the reference that point to teachings of not connecting the inner and outer layers further supporting that Berardi understood that this was a known feature in the art (Answer 4).

We determine that the Examiner's statements are insufficient to support a determination, based on a substantial evidence, that it was old and well known, prior to the filing of Appellant's application, to provide "a continuous inner liner disposed within the external conduit and secured to the external conduit only at ends of the continuous inner liner" as recited in claim 1.

We note that the Examiner does not direct our attention to any place where Berardi discloses it was old or well known, prior to the filing date of Appellant's application, to use "a continuous inner liner disposed within the external conduit and secured to the external conduit only at ends of the continuous inner liner," as claimed, and does not direct our attention to anywhere Berardi describes any other reference as disclosing such an old and well known inner liner. Even the Examiner's ostensible reliance on Fujimoto, discussed in Berardi's column 5, is insufficient, as it is unclear whether the Examiner finds that Fujimoto does or does not disclose the claimed inner liner, and because it appears that Fujimoto does not, in fact,

disclose such an inner liner. *See* Answer 6 (“[A]ppellant[’]s arguments with regards to Fujimoto are immaterial when this reference is not in fact being used as the teaching reference, but was only given as further support that Berardi knew this feature to be old and known in the art”); *see also* Appeal Br. 9 (“Fujimoto also clearly describes and illustrates that there are other points between the inner wall 2 and the outer wall 3 that do remain bonded. *See, e.g.,* [Fujimoto] FIGS. 1[–]3.” Further, we decline to review, without further guidance from the Examiner, any of the more than two dozen references discussed by Berardi to determine whether any discloses (while predating the filing date of Appellant’s application) “a continuous inner liner disposed within the external conduit and secured to the external conduit only at ends of the continuous inner liner.”

Thus, based on the foregoing, we do not sustain the rejection of independent claim 1, or the rejection of claims 2–9 that depend from claim 1. *See* Appeal Br., Claims App. Further, inasmuch as each of independent claims 10 and 15 recites a similar limitation as claim 1, and are rejected for similar reasons as claim 1, we do not sustain the rejection of independent claims 10 or 15, or the rejection of their dependent claims 11–14 and 16–20. *See* Appeal Br., Claims App.; *see also* Answer 2–3. We note that with respect to independent claim 15, which recites “a continuous liner configured to be secured to one or more additional layers only at ends of the continuous liner” (Appeal Br., Claims App.), the Examiner does not make any findings apart from those based on Berardi that Kolzumi’s liner is capable of being or otherwise may be secured to one or more of Kolzumi’s additional layers only at ends of the liner (*see* Answer 2–3).

Appeal 2015-001286
Application 12/689,931

DECISION

We REVERSE the Examiner's obviousness rejection of claims 1–20.

REVERSED